

REMARKS

This reissue application was filed with claims 1-83, of which claims 39 and 40 were amended and claims 79-83 added by Preliminary Amendment filed with the application. By the Office Action dated 12/23/2005, claims 1-83 were rejected as being based upon a defective Reissue Declaration in that the declaration did not mention the application from which the patent for which reissue is sought claims foreign priority, PCT/US92/10209. Submitted herewith is a Supplemental Reissue Declaration, correcting this defect in the originally filed Reissue Declaration, obviating such rejection of claims 1-83.

In addition, by the 12/23/2005 Office Action, claims 40 and 79-83 were rejected under 35 U.S.C. §112, first paragraph, the examiner stating that "the recitation that the two lamps are substantially parallel and in the same direction, and that the only exposed part of the second lamp being exposed is its refractive lens, are not explicitly stated in the original patent, although the drawings appear to show that they point in generally similar directions." Claims 40 and 79-83 were further rejected under 35 U.S.C. §251 as being based upon new matter, specifically the same material mentioned by the examiner with respect to the §112 rejection. Applicant respectfully traverses such rejections and requests reconsideration of this reissue application, for the reasons discussed below.

By the above Amendment, claims 40 and 79-83 have been further amended, new claims 84-85 have been added, and the patent's written description has been amended for explicitly describing the subject matter originally contained in the drawings and presently recited in claims 40 and 79-85.

Applicant's attorney thanks Examiner Stephen J. Kalafut for the assistance and courtesies extended during a telephone interview on February 22 and 24, 2006, between applicant's undersigned attorney and the examiner. During that interview, applicant's attorney and the examiner discussed claim language for more appropriately reciting the matter contained in the original drawings with respect to the orientation of applicant's first and second lamps and the location of the second lamp's refractive lens in the reflector. The precise language of claims 40 and 79-85 as presented in the above Amendment was specifically discussed, and the examiner indicated that those claims would comply with the requirements of §112, second

paragraph, and would not be based upon new matter added to the patent from which reissue is sought in violation of §251.

Specifically, applicant's attorney pointed out that FIGs. 1 and 2 of the original patent show the lamps 12 and 13 to be substantially parallel to each other and pointed in the same direction, and further that the light beam arrows 14 and 15 of FIGs. 1 and 2 show the light beams 14 and 15 respectively generated by the lamps 12 and 13 as being substantially parallel to one another and pointed in substantially the same direction, further indicating that the two lamps 12 and 13 are pointed in substantially the same direction and are substantially parallel to each other.

During the interview, applicant's attorney noted that the language of Claims 40, 79, 80 and 83 as recited in the Preliminary Amendment appears to be redundant, however, since the recitation of the two lamps as pointed in the same direction would appear to require that the lamps be parallel to each other. It was agreed that the orientation of the two lamps (12 and 13) would be more appropriately recited in the claims in terms of the general direction of their respective light beams (14 and 15) shown in FIGs. 1 and 2, i.e. that the second lamp (13) is oriented for generating its light beam (15) in a generally similar direction as the light beam (14) generated by the first lamp (12). Accordingly, such language is recited in claim 40 as amended by the present Amendment, and is recited in claims 79, 80, 83 and 85 added by the present Amendment, and the examiner indicated in the interview that these claims would be allowable.

The Preliminary Amendment further added independent Claim 81, defining an electric light source having a reflector with first and second openings, the first opening located at the center of the reflector and the second opening located to the side of the first opening; a first electric lamp positioned in the first opening and having a filament at the focal point of the reflector; and a second electric lamp having a refractive lens, the second lamp recessed in the second opening in the reflector such that substantially only its refractive lens is exposed in the reflector. This claim was rejected under 35 U.S.C. §112, first paragraph (written description), and under §251 (new matter), the examiner indicating that the original patent disclosure does not explicitly state that the refractive lens is the only exposed part of the second lamp being exposed in the reflector. During the aforementioned examiner interview, applicant's attorney

suggested the language recited in claim 81 as amended by the present Amendment, i.e. that the second lamp (13) is “recessed in said second opening in said reflector with said refractive lens of said second electric lamp exposed in said reflector”, as well as the language recited in new independent claim 84 (added by the present Amendment) which claim 84 is similar to claim 81 except that the second electric lamp’s refractive lens is recited as being “adjacent to said reflector at said second opening”. The examiner indicated that independent Claims 81 and 84 as presented in the present Amendment (as well as dependent Claims 82, 83 and 85) are supported by FIGs. 1 and 2 of the original patent, and that these claims would be allowable.

Further, the above Amendment amends the specification (the paragraph at column 11 line 56 through column 12 line 5) for explicitly describing the subject matter originally contained in the drawings and presently recited in Claims 40 and 79-85.

In *In re Wolfensperger*, 302 F.2d 950, 133 USPQ 537 (CCPA 1962), the original drawings were held to provide the written description of the invention under §112, first paragraph, for matter omitted from the written disclosure portion of the application. With respect to the written description requirement under §112, first paragraph, and the addition to the specification in words of matter shown in the drawing, the CCPA stated in *Wolfensperger*, 133 USPQ at 542:

“The practical, legitimate enquiry in each case of this kind is what the drawing in fact discloses to one skilled in the art. Whatever it does disclose may be added to the specification in words without violation of the statute and rule which prohibit ‘new matter’, 35 U.S.C. 132, Rule 118, for the simple reason *that* what is originally disclosed cannot be ‘new matter’ within the meaning of this law. If the drawing, then, contains the necessary disclosure, it *can* ‘form the basis of a valid claim.’” [Italics in original.]

“Thus, *Wolfensperger* teaches that the drawing may provide the basis for subsequent amendments to the specification without producing prohibitory new matter therein.” Irah H. Donner, *Patent Prosecution*, The Bureau of National Affairs (4th Ed. 2005), at Chapter 9.IV.C.

A separate paper entitled “Status of Claims and Support for Claim Changes (37 CFR 1.173(c))” accompanies this Amendment.

A new "Statement Under 37 CFR 3.73(b)", setting forth the chain of title with greater specificity, accompanies this Amendment. Please substitute the accompanying Statement for the "Statement Under 37 CFR 3.73(b)" originally filed with this reissue application.

Enclosed is a check in the amount of \$150 to cover the claims added by the above Amendment, as calculated on the attached Fee Determination Record. If the enclosed fee is deficient in any manner, please charge any such deficiency to Deposit Account No. 23-0822.

Conclusion

Applicant submits that the amendments above are supported by the original patent for which reissue is sought and do not introduce prohibitory new matter in the patent; that the Supplemental Declaration submitted herewith corrects any defect in the Reissue Application Declaration originally filed in this application; and that all claims in this application patentably define over the prior art of record. The foregoing amendments are believed to place this reissue application in condition for allowance, and applicant respectfully requests issuance of a Notice of Allowance as to all pending claims (Claims 1-85).

Respectfully submitted,

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